

REMARKS

Claims 22-34, 36-38, 54-59, 78-86, 93-122, 124, 126, 128, and 130-133 are pending in the Application. Claims 22-34, 36-38, 54-59, 78-86, 93-95, and 122, 124, 126, and 128 stand rejected and claims 96-121 and 130-133 stand withdrawn, in the Office action mailed August 31, 2010. Claims 22, 30, 54, and 78 are independent claims. Claims 23-29 and 122, claims 31-34, 36-38, and 124, claims 55-59, 93-95, and 126, and claims 79-86, and 128 depend, respectively, from independent claims 22, 30, 54, and 78.

The Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is **essential** that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. § 2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office Action sets forth "all reasons and bases" for rejecting the claims.

Applicants respectfully request reconsideration of the pending claims, in view of the amendments set forth above, in light of the arguments that follow.

Amendments to Claims

Claims 22, 30, 54, and 78 have been amended as shown above to clarify aspects of those claims. Applicants respectfully submit that support for these amendments may be found, for example, at FIG. 55a, FIG. 56a, FIG. 57, and FIG. 63, and at page 254, line 12 to page 264, line 18; at page 271, line 12 to page 277, line 9; and page 277, line 10 to page 291, line 10. Applicants respectfully submit that the amendments to claims 22, 30, 54, and 78 do not add new matter.

Rejections of Claims

Claims 22-24, 28-30, 32-34, and 36 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sharman (H1641) in view of Flammer (US 5,400,338) and Iwami, *et al.* (US 5,604,737, "Iwami"). Claims 25 and 31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sharman in view of Flammer, Iwami, and allegedly admitted prior art. Claims 26, 27, 37, and 38 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sharman in view of Flammer, Iwami, and Heidari (US 5,550,893). Claims 54, 58, 59, 78, 82-86, 93-95, 122, 124, 126, and 128 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sharman in view of Flammer, Iwami, and Mahany (US 4,910,794). Claims 55 and 79 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sharman in view of Flammer, Iwami, Mahany, and allegedly admitted prior art. Claims 56, 57, 80, and 81 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sharman in view of Flammer, Iwami, Mahany, and Heidari.

Applicants respectfully traverse the rejections. Nevertheless, Applicants have amended claims 22, 30, 54, and 78 as shown above, rendering the rejections of the instant Office action moot.

Applicants respectfully note that all claims are rejected for alleged reasons of obviousness. Applicants now review requirements for a rejection based on obviousness.

According to M.P.E.P. §2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not

produce a *prima facie* case, **the applicant is under no obligation to submit evidence of nonobviousness.**" (emphasis added) M.P.E.P. §2142 further states that "[t]he **key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.**" (emphasis added) As recognized in M.P.E.P. §2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), 82 USPQ2d 1385, 1396 noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." In addition, the Federal Circuit has made clear that "rejections on obviousness **cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.**" *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 127 S. Ct. 1727 (2007), 82 USPQ2d at 1396. (emphasis added)

As noted in the Manual of Patent Examining Procedure (Revision 7, July 2008), "[t]o establish *prima facie* obviousness of a claimed invention, **all** the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." (emphasis added) See MPEP at 2143.03. Further, "[**a**ll] words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA)." (emphasis added) *Id.*

Thus, the law is clear that **words of a claim cannot be merely disregarded during examination.** Instead, **all the words in a claim must be considered during the examination process.**

Additionally, referring to the PTO's published guidelines of October 10, 2007, with regard to the procedure to be followed by Examiners when making an obviousness rejection, the guidelines recite **seven rationales** supporting an obviousness rejection and give specific findings that **must be made** by an Examiner in order for the Examiner to use the rationale to support a finding of obviousness. These findings are **not optional and must be articulated by the Examiner for the rationale to apply.** The seven rationales are shown below.

- (A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

If the present rejection is maintained, or any new rejection based on obviousness is asserted, the Applicants respectfully request that any subsequent action: 1) **identify the specific Rationale** (i.e., by explicitly indentifying one of **A through G** noted above) in the Guidelines that the Examiner is using to support the obviousness rejection so that the Applicants may more clearly address the Examiner’s concerns, and 2) **state on the record** the **required** factual findings to support the Rationale that the Examiner has chosen.

As indicated recently, “[i]t is important for Office personnel to recognize that when they do choose to formulate an obviousness rejection using one of the rationales suggested by the Supreme Court in *KSR* and discussed in the *2007 KSR Guidelines*, they are to adhere to the instructions provided in the MPEP regarding the **necessary factual findings**.” See September 1, 2010 Examination Guidelines Update, 75 Fed. Reg. 169.

Indeed, “if a rejection has been made that omits one of the required factual findings, and in response to the rejection a practitioner or inventor points out the omission, Office personnel **must** either withdraw the rejection, or repeat the rejection **including all the required factual findings.**” *See id.*

Further, “[s]imply stating the principle ... without providing an explanation of its applicability to the facts of the case at hand is generally not sufficient to establish a *prima facie* case of obviousness.” *See id.*

“[T]he Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.” *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

Thus, as indicated above, the Applicants respectfully request that any subsequent Office Action that asserts an obviousness rejection **specifically identify** which rationale it is using, and then provide **the required factual findings** with respect to the rationale.

I. The Proposed Combination Of Sharman, Flammer, Iwami Does Not Render Claims 22-24, 28-30, 32-34, And 36 Unpatentable

Claims 22-24, 28-30, 32-34, and 36 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sharman (H1641) in view of Flammer and Iwami. Applicants respectfully traverse the rejection.

With regard to independent claim 22, Applicants respectfully submit that claim 22 has been amended so that it now recites, in part, “...wherein the portable terminal device transmits to a first remote system a request for information identifying a second remote system accessible to the portable terminal device via the wireless packet network and operable to, at least, convert between digital voice packets of the portable terminal device and voice signals compatible with a public telephone network.” Claims 30, 54, and 78 recite similar features. Applicants respectfully submit that the cited art does not teach at least this aspect of amended claim 22.

The Office action, at page 3, states that “Sharman suggest[s] the portable terminal device (102) communicating via a wireless packet network with a remote system (e.g. Local Area Network Access Gateway 107) operable to, at least, communicatively couple the portable terminal device to a public telephone network (103) (see Figure 3 col. 3 lines 46-60).” The Office goes on to admit that “Sharman does not teach that the portable terminal device transmits a request for information identifying the remote system accessible to the portable terminal device via the wireless packet network, and receiving the requested information from the remote system.” See August 31, 2010 Office action at page 3. The Office then asserts that the teaching by Flammer of a “roaming node” transmitting an “acquisition/synchronization packet” to a “stationary node” teaches Applicants’ claimed “portable terminal device.” *Id.*

Applicants have amended the relevant part of claim 22 so that it now recites, in part, “...wherein the portable terminal device transmits to a first remote system a request for information identifying a second remote system accessible to the portable terminal device via the wireless packet network and operable to, at least, convert between digital voice packets of the portable terminal device and voice signals compatible with a public telephone network.” Applicants respectfully submit that the “acquisition/synchronization packet” of Flammer identified by the Office does not teach or suggest “a request [transmitted to a first remote system] for information identifying a second remote system accessible to the portable terminal device via the wireless packet network and operable to, at least, convert between digital voice packets of the portable terminal device and voice signals compatible with a public telephone network.” Instead, Flammer teaches that the “roaming node” transmits an “acquisition/synchronization packet” on “various network channels to any stationary nodes that can hear the transmission,” and that “[t]he roaming node then receives an acquisition/synchronization packet back from each stationary node that heard a packet.”

Applicants respectfully submit that Flammer does not teach, suggest, or disclose that any of the “stationary nodes” is “operable to, at least, convert between digital voice packets of the portable terminal device and voice signals compatible with a public telephone network,” let alone those that “heard a packet” and responded with an “acquisition/synchronization packet.” Further, Applicants respectfully submit that

Flammer does not teach, suggest or disclose that any of the “stationary nodes” that “heard a packet” respond with “information identifying a second remote system accessible to the portable terminal device via the wireless packet network and operable to, at least, convert between digital voice packets of the portable terminal device and voice signals compatible with a public telephone network,” as recited by amended claim 22. Applicants respectfully submit that the remaining cited art is silent with regard to these aspects of amended claim 22. Therefore, Applicants respectfully submit that the proposed combination of references does not teach, suggest, or disclose at least these aspects of amended claim 22.

Applicants have also amended claim 22 so that it now recites, in part, “...wherein the portable terminal device, upon receiving the requested information, sends a message identifying a subscriber on the public telephone network, to the second remote system, to initiate a call connection through the second remote system to the subscriber on the public telephone network, using the requested information.” Applicants respectfully submit that the proposed combination of references does not teach, suggest or disclose all of these features now recited by claim 22.

For example, Applicants respectfully submit that the cited art, taken alone or in combination, does not teach, suggest, or disclose a “portable terminal device” that “upon receiving the requested information [identifying a second remote system accessible to the portable terminal device via the wireless packet network and operable to, at least, convert between digital voice packets of the portable terminal device and voice signals compatible with a public telephone network], sends a message indentifying a subscriber on the public telephone network. The Office admits that Sharman and Flammer do not teach, suggest, or disclose, *inter alia*, a “portable terminal” that “upon receiving the requested information, initiates a call connection through the remote system.” See August 31, 2010 Office action at page 4. The Office identifies Iwami at col. 13, lines 31-46 as relevant. Applicants respectfully submit, however, that the Office has not shown that either the cited portion, or any other text or figure of Iwami teaches, at least, “upon receiving the requested information,” the “communication terminal 10” initiates a call connection through the remote system,” in the manner claimed. The cited portion of Iwami fails to mention any “request for

information” by the “communication terminal 10”, and also fails to disclose that any “requested information” is sent by the “communication server 20” to the “communication terminal 10,” as was required prior to the present amendment of claim 22, and is still a requirement of claim 22. Applicants respectfully submit that the Office ignores the language of claim 22 that requires that the “initiating” occur “upon receiving the requested information.” Instead, Iwami teaches that a “voice communication request” is sent to the “communication server 20” when a user “selects communication with a telephone.” See *id.* at col. 13, lines 31-34. Therefore, the “communication terminal 10” is not described as “receiving the requested information,” and does not teach, suggest, or disclose “initiating a call connection” “upon receiving the requested information,” as required by claim 22. Applicants respectfully submit, therefore, that the Office has not demonstrated that the proposed combination of Sharman, Flammer, and Iwami teaches at least these aspects of claim 22. For at least these reasons, Applicants respectfully submit that the proposed combination of references does not teach, suggest, or disclose all aspects of claim 22, and that claim 22 and its dependent claims are allowable over the cited art.

With regard to independent claim 30, Applicants respectfully submit that claim 30 has been amended so that it recites features similar to those of claim 22, was rejected over the same art using the same arguments presented in the rejection of claim 22, and that claim 30 and any claims that depend from claim 30 are therefore allowable over the cited art for at least some of the reasons set forth above.

Therefore, for at least the reasons set forth above, Applicants respectfully submit that claims 22 and 30 are allowable over the cited art. Applicants respectfully submit that because claims 23-29, and 122 depend from allowable claim 22, and claims 31-34, 36-38, and 124 depend from allowable claim 30, that those claims are also allowable over the proposed combination of Sharman, Flammer, and Iwami. Accordingly, Applicants respectfully request that the rejection of claims 22-24, 28-30, 32-34, and 36 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

II. The Proposed Combination Of Sharman, Flammer, Iwami, And Allegedly Admitted Prior Art Does Not Render Claims 25 and 31 Unpatentable

Claims 25 and 31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sharman in view of Flammer, Iwami, and allegedly admitted prior art. Claims 25 and 31 depend, respectively from independent claims 22 and 30. Applicants respectfully submit that claims 22 and 30 are allowable over the cited art, in that the Office has not shown that the allegedly admitted prior art overcomes the shortcomings of Sharman, Flammer, and Iwami, as set forth above. Because claims 22 and 30 are allowable over the cited art, Applicants respectfully submit that claims 25 and 31 that depend therefrom are also allowable, for at least the same reasons. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 25 and 31 under 35 U.S.C. §103(a).

III. The Proposed Combination Of Sharman, Flammer, Iwami, And Heidari Does Not Render Claims 26, 27, 37, And 38 Unpatentable

Claims 26, 27, 37, and 38 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sharman in view of Flammer, Iwami, and Heidari. Claims 26 and 27 and claims 37 and 38 depend, respectively from independent claims 22 and 30. Applicants respectfully submit that claims 22 and 30 are allowable over the cited art, in that the Office has not shown that Heidari overcomes the shortcomings of Sharman, Flammer, and Iwami, as set forth above. Because claims 22 and 30 are allowable over the cited art, Applicants respectfully submit that claims 26, 27, 37, and 38 that depend therefrom are also allowable, for at least the same reasons. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection if claims 26, 27, 37, and 38 under 35 U.S.C. §103(a).

IV. The Proposed Combination Of Sharman, Flammer, Iwami, And Mahany Does Not Render Claims 54, 58, 59, 78, 82-86, 93-95, 122, 124, 126, And 128 Unpatentable

Claims 54, 58, 59, 78, 82-86, 93-95, 122, 124, 126, and 128 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sharman in view of Flammer, Iwami, and Mahany. Applicants respectfully traverse the rejection.

With regard to independent claims 54 and 78, Applicants respectfully submit that claims 54 and 78 have been amended so that they now recite features similar in many ways to those of independent claims 22 and 30, and that the Office rejects those common features over the same combination of art for the same reasons asserted in the rejection of claims 22 and 30. Applicants have shown above with respect to the rejections of claims 22 and 30 that the proposed combination of Sharman, Flammer, and Iwami does not teach certain features of claims 22 and 30 also recited by claims 54 and 78. Further, the Office does not assert that Mahany teaches those aspects of claims 54 and 78 that Applicants have demonstrated are not disclosed by the proposed combination of Sharman, Flammer, and Iwami. Because Applicants have shown that Sharman, Flammer, and Iwami do not teach claim features shared by claims 22, 30, 54, and 78, and the Office does not demonstrate that Mahany teaches those features of claims 54 and 78, Applicants respectfully submit that the Office has not shown that the combination of Sharman, Flammer, Iwami, and Mahany teaches at least those features of claims 54 and 78, and that claims 54 and 78 are therefore allowable over the cited art. Applicants respectfully submit that dependent claims 58, 59, 82-86, 93-95, 122, 124, 126, and 128 depend, directly or indirectly, from allowable claims 54 and 78, and are therefore also allowable over the proposed combination of references. Accordingly, Applicants respectfully request that the rejection of claims 54, 58, 59, 78, 82-86, 93-95, 122, 124, 126, and 128 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

V. The Proposed Combination Of Sharman, Flammer, Iwami, And Allegedly Admitted Prior Art Does Not Render Claims 55 And 79 Unpatentable

Claims 55 and 79 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sharman in view of Flammer, Iwami, Mahany, and allegedly admitted prior art. Claims 55 and 79 depend, respectively from independent claims 54 and 78. Applicants

respectfully submit that claims 54 and 78 are allowable over the cited art, in that the Office has not shown that the allegedly admitted prior art overcomes the shortcomings of Sharman, Flammer, and Iwami, as set forth above. Because claims 54 and 78 are allowable over the cited art, Applicants respectfully submit that claims 55 and 79 that depend therefrom are also allowable, for at least the same reasons. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 55 and 79 under 35 U.S.C. §103(a).

VI. The Proposed Combination Of Sharman, Flammer, Iwami, And Heidari Does Not Render Claims 56, 57, 80, And 81 Unpatentable

Claims 56, 57, 80, and 81 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sharman in view of Flammer, Iwami, and Heidari. Claims 56 and 57 and claims 80 and 81 depend, respectively, from independent claims 54 and 78. Applicants respectfully submit that claims 54 and 78 are allowable over the cited art, in that the Office has not shown that Heidari overcomes the shortcomings of Sharman, Flammer, and Iwami, as set forth above. Because claims 54 and 78 are allowable over the cited art, Applicants respectfully submit that claims 56, 57, 80, and 81 that depend therefrom are also allowable, for at least the same reasons. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection if claims 56, 57, 80, and 81 under 35 U.S.C. §103(a).

Newly Added Claims

Applicants have added new claims 134-149. Claims 134-137, 138-141, 142-145, and 146-149 depend, respectively, from independent claims 22, 30, 54, and 78, which have been shown to be allowable. Therefore, Applicants respectfully submit that claims 134-149 which depend from those claims are also allowable for at least the reasons set forth above. Support for new claims 134-149 may be found, for example, at FIG. 55a, FIG. 56a, FIG. 57, and FIG. 63, and at page 254, line 12 to page 264, line 18; at page 271, line 12 to page 277, line 9; and page 277, line 10 to page 291, line 10. Applicants respectfully submit that no new matter has been added.

Conclusion

In general, the Office action has made various statements regarding the claims and the cited references during the course of prosecution that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that all of pending claims 22-34, 36-38, 54-59, 78-86, 93-95, 122, 124, 126, 128, and 134-149 are in condition for allowance. Therefore, allowance of those claims is respectfully requested.

The Commissioner is hereby authorized to charge any fees required by this submission to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000 to resolve any issues.

Respectfully submitted,

Dated: November 8, 2010
McAndrews, Held & Malloy, Ltd.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
(312) 775-8000

By /Kevin E. Borg/
Kevin E. Borg
Agent for Applicants
Reg. No. 51,486